

Remarks/Arguments

Reconsideration of this application in light of the following remarks is requested.

No claims are presently, amended, added or deleted by this response. Claims 1-11 remain pending in the present application.

Rejections Under 35 U.S.C. § 103

Claim 1

Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application No. 2002/0160688 to Rehkemper ("Rehkemper") in view of U.S. Patent No. 2,587,142 to Gray ("Gray") and U.S. Patent No 6,632,121 to Edmisson ("Edmisson"). Applicant traverses this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness with respect to claim 1.

Claim 1 recites:

A radio-controlled toy car and controller kit, the kit comprising:
an unassembled toy car, the unassembled toy car comprising a chassis having a pair of wheels, a motor adapted to be removably inserted into the chassis, a pair of hubcaps adapted to be removably secured to the wheels, and a pair of tires adapted to be removably secured to the wheels; and
a controller for transmitting radio signals to the toy car.

As the PTO recognizes in MPEP § 2142:

...The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...

It is submitted that, in the present case, the Examiner cannot factually support a *prima facie* case of obviousness for the following mutually exclusive reasons.

1. Even When Combined, the References Do Not Teach the Claimed Subject Matter

The Rehkemper, Gray, and Edmisson references cannot be applied to reject claim 1 under 35 U.S.C. § 103 which provides that:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the combination of Rehkemper, Gray, and Edmisson does not teach, among other things, a pair of wheels and a pair of hubcaps adapted to be removably secured to the wheels.

The Examiner concedes that Rehkemper fails to disclose a pair of hubcaps adapted to be removably secured to the wheels. (See Final Office Action, page 2). Applicant assumes that, because the Examiner has failed to indicate otherwise. The Examiner also concedes that Edmisson also fails to disclose a pair of hubcaps adapted to be removably secured to the wheels. Attempting to cure such shortcomings of Rehkemper and Edmisson, the Examiner argues that the front hubcaps 24 in Gray are adapted to be removably secured to the front wheels 21. (Final Office Action, paragraph bridging pages 4-5). Applicant respectfully traverses the Examiner's argument, because the hubcaps 24 in Gray are not adapted to be removably secured to the front wheels 21. In contrast, Gray explicitly discloses that the hubcaps 24 "screw on the extremities of the threaded spindles 22." (Column 2, lines 26-32).

The Examiner also argues that, in Gray, "one can unscrew the extremities of the threaded spindles in order to remove the front hubcaps." (Final Office Action, paragraph bridging pages 4-5). Applicant respectfully traverses the Examiner's argument because Gray does not teach, imply or even suggest that the threaded spindles 22 can be unscrewed. To the contrary, one having ordinary skill in the art would recognize that the threaded spindles 22 are not capable of

being unscrewed from the front axle 14. To provide otherwise would present the possibility that the spindles 22 would inadvertently become unscrewed from the axle 14 in response to rotation of the wheels 21 because rotation of the axle 14 is prevented by the bolt 16. Moreover, even if the spindles 22 could be unscrewed, such aspect fails to cure the shortcoming that the hubcaps 24 are not adapted to be removably secured to the wheels 21 – that is, whether or not the spindles 22 can be unscrewed has no bearing whatsoever on whether or not the hubcaps 24 are adapted to be removably secured to the wheels 21.

The Examiner also argues, in reliance upon *In re Hutchinson*, 154 F.2d 135, 69 USPQ 138 (CCPA 1946), that “adapted to” does not constitute a limitation in any patentable sense (Final Office Action, page 4). In *Hutchinson*, the court did not consider the preamble phrase “adapted for use in the fabrication of a metal template or the like” to “constitute a limitation in any patentable sense.” See *Hutchinson*, 154 F.2d at 138, 69 USPQ at 141. In contrast, “adapted to” in the present application imposes a capability requirement on the hubcap, *i.e.*, the hubcaps recited in claim 1 of the present application must be removably securable to wheels.

There is nothing inherently wrong with defining some part of an invention in functional terms. (MPEP 2173.05(g)). Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). A functional limitation must be evaluated and considered, just like any other limitation of the claim - for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. (MPEP 2173.05(g)). A functional limitation can be used in association with an element to define a particular capability or purpose that is served by the recited element. See, for example, *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976) wherein the Court held that in a claim directed to **A KIT OF** component parts capable of being assembled, limitations such as “members adapted to be positioned” and “portions . . . being resiliently dilatable whereby said housing may be slidably positioned” serve to precisely define present structural attributes of interrelated component parts of the claimed assembly.

Thus, the Examiner’s summary dismissal of anything following the phrase “adapted to” as not constituting a limitation in any patentable sense is not applicable to claim 1 in the present

application. Accordingly, because “adapted to” imposes a capability requirement, and in light of the Examiner’s concession that Rehkemper and Edmisson each fail to disclose hubcaps that are removably securable to wheels, and also that Gray clearly discloses threading the hubcaps to threaded spindles and not to the wheels, the combination of Rehkemper, Edmisson, and Gray cannot support a *prima facie* case of obviousness of claim 1 of the present application, or any other claim reciting wheels and hubcaps adapted to be secured to the wheels.

Thus, for this mutually exclusive reason, the Examiner’s burden of factually supporting a *prima facie* case of obviousness clearly cannot be met, and any rejection under 35 U.S.C. § 103 is not applicable to claim 1.

2. The Combination of References is Improper

There is still another, mutually exclusive and compelling reason why the Rehkemper, Gray, and Edmisson references cannot be applied to reject claim 1 under 35 U.S.C. § 103.

§ 2142 of the MPEP also provides:

...the examiner must step backward in time and into the shoes worn by the hypothetical “person of ordinary skill in the art” when the invention was unknown and just before it was made.....Knowledge of the applicant’s disclosure must be put aside ... impermissible hindsight must be avoided.

Here, neither Rehkemper, Gray, nor Edmisson teaches, or even suggests, the desirability of combination to arrive at the recitation of claim 1 since they each fail to teach “a pair of hubcaps adapted to be removably secured to the wheels,” as recited in claim 1.

Thus, it is clear that neither Rehkemper, Gray, nor Edmisson provides any incentive or motivation supporting the desirability of combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection of claim 1.

In this context, the MPEP further provides at § 2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the combination of the Rehkemper, Gray, and Edmisson references arises solely from hindsight based on the invention without any showing, suggestion, incentive, or motivation in any of the references for the combination as applied to claim 1. The Examiner argues that any judgment on obviousness is, in a sense, necessarily a reconstruction based upon hindsight reasoning, but that such reconstruction is proper IF the reconstruction takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made AND does not include knowledge gleaned only from Applicant's disclosure. The Examiner further argues that such hindsight reconstruction is proper in this case. (Final Office Action, pages 3-4).

However, modifying Rehkemper to employ hubcaps as taught by Gray would only provide a Rehkemper device that includes hubcaps screwed to spindles. Because the Examiner has failed to provide any reference teaching or suggesting a kit including, among other things, a pair of wheels and a pair of hubcaps adapted to be removably secured to the wheels, the Examiner has not established that such hubcaps were within the level of ordinary skill at the time the claimed invention was made. It is, thus, only logical to infer that modification of any reference currently of record to arrive at claim 1 of the present application necessarily included knowledge gleaned only from Applicant's disclosure.

The Examiner further argues that one of ordinary skill in the art would have been motivated to modify Rehkemper to employ hubcaps as taught by Gray "in order to make the device more realistic." (Final Office Action, pages 3-5). The Applicant respectfully traverses the Examiner's argument, and respectfully invites the Examiner to provide support for the assertion that one skilled in the art would employ the teachings of Gray, in 1947, to modify the teachings of Rehkemper, filed in 2002, "in order to make the Rehkemper device more realistic." The Applicant also notes that Rehkemper's device is an interactive, remote control, battling robot for children that is configurable with weaponry and operable such that functionality can be removed

or limited based on collisions or damages (paragraphs 2-3), and respectfully invites the Examiner to provide support for the assertion that one skilled in the art would be motivated to modify such a device by adding Gray's hubcaps "in order to make the Rehkemper device more realistic." It is unclear how enhancing realism of a child's weapon-laden robot toy would be motivation to anyone skilled in the art to modify such a toy, much less how any portion of the teachings found in Gray might provide such motivation or otherwise render such a toy more realistic.

Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met, and the rejection under 35 U.S.C. § 103 is not applicable to claim 1.

3. Prior Art That Teaches Away From the Claimed Invention Cannot be Used to Establish Obviousness

In the present case the Gray reference, by providing sufficient play for the front wheels 21 between the corresponding shoulders 23 and hubcaps 24 to permit the front wheels 21 to rotate freely on their respective spindles 22 (column 2, lines 36-40), is directed to a toy car having front wheels that rotate relative to corresponding hubcaps. Modifying the hubcaps in Gray such that the hubcaps 24 are also removably secured to the wheels 21 would prevent rotation of the wheels 21. Thus, Gray clearly teaches away from claim 1.

Since it is well recognized that teaching away from the claimed invention is a *per se* demonstration of lack of *prima facie* obviousness, it is clear that the Examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

Thus, for this reason alone, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met, and the rejection under 35 U.S.C. § 103 should be withdrawn.

Claim 10

Claim 10 was also rejected under 35 U.S.C. § 103(a) as being unpatentable over Rehkemper in view of Gray and Edmisson. Applicant traverses this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness with respect to claim 10.

Claim 10 recites:

A toy car kit having a plurality of unassembled toy car components, the unassembled components, comprising:
a chassis having a pair of front wheels;
a pair of hubcaps attachable to the front wheels;
a pair of tires attachable to the front wheels;
a motor adapted for insertion into a compartment of the chassis, the motor having a drive gear associated therewith;
a motor retaining clip attachable to the chassis to secure the motor to the chassis;
a transfer gear attachable to the chassis and engaging the drive gear;
an axle attachable to the chassis, the axle having an axle gear for engaging with the transfer gear and a pair of rear wheels fixedly disposed on the axle;
a pair of hubcaps attachable to the rear wheels;
a pair of tires attachable to the rear wheels; and
a body attachable to the chassis;
wherein the unassembled components are packaged in the kit.

Thus, claim 10 includes recitation similar to the recitation of “a pair of hubcaps adapted to be removably secured to the wheels” as recited in claim 1. Consequently, each of the above-described mutually exclusive reasons for why the Examiner cannot factually support a *prima facie* case of obviousness of claim 1 are also applicable to claim 10.

Moreover, Rehkemper, Edmisson, and Gray also fail to teach or suggest a toy car kit having a plurality of unassembled toy car components, wherein the unassembled components are packaged in the kit, as recited in claim 10, among other elements. None of the cited references disclose that the kit components are packaged in an unassembled state, as recited in claim 10.

Each of the cited references also fails to disclose any packaging whatsoever. When evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the combination of Rehkemper, Gray, and Edmisson does not teach a kit that includes unassembled components packaged in the kit, among other things. As the PTO recognizes in MPEP § 2142, the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness.

Claim 11

Claim 11 was also rejected under 35 U.S.C. § 103(a) as being unpatentable over Rehkemper in view of Gray and Edmisson. Applicant traverses this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness with respect to claim 11.

Claim 11 recites:

A toy car kit comprising:
a housing;
a plurality of unassembled toy car components disposed in
the housing, the unassembled components comprising:
a chassis having a pair of front wheels;
a pair of hubcaps attachable to the front wheels;
a pair of tires attachable to the front wheels;
a motor adapted for insertion into a compartment of
the chassis, the motor having a drive gear associated
therewith;
a motor retaining clip attachable to the chassis to
secure the motor to the chassis;
a transfer gear attachable to the chassis and
engaging the drive gear;
an axle attachable to the chassis, the axle having an
axle gear for engaging with the transfer gear and a pair of
rear wheels fixedly disposed on the axle;
a pair of hubcaps attachable to the rear wheels;
a pair of tires attachable to the rear wheels; and
a body attachable to the chassis.

Thus, claim 11 includes recitation similar to the recitation of “a pair of hubcaps adapted to be removably secured to the wheels” as recited in claim 1. Consequently, each of the above-described mutually exclusive reasons for why the Examiner cannot factually support a *prima facie* case of obviousness of claim 1 are also applicable to claim 11.

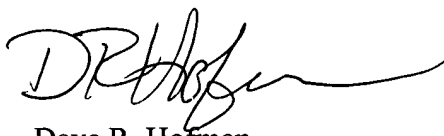
Moreover, Rehkemper, Edmisson, and Gray also fail to teach or suggest a toy car kit comprising a housing and a plurality of unassembled toy car components disposed in the housing, as recited in claim 11, among other elements. None of the cited references disclose that the kit components are disposed in a housing in an unassembled state, as recited in claim 11. Each of the cited references also fails to disclose any housing whatsoever in which all of the car components are housed. When evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the combination of Rehkemper, Gray, and Edmisson does not teach a kit that includes unassembled components disposed in a housing in the kit, among other things. As the PTO recognizes in MPEP § 2142, the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness.

Conclusion

It is clear from all of the foregoing that independent claims 1, 10, and 11 are in condition for allowance. Dependent claims 2-9 depend from and further limit independent claim 1 and, therefore, are allowable as well.

An early formal notice of allowance of claims 1-11 is requested.

Respectfully submitted,



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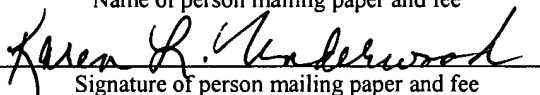
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